

REMARKS

The Restriction Requirement states that restriction to one of the following inventions is required under 35 U.S.C § 121:

- I. Claims 27-30, 38, and 39, drawn to transmitting a cookie based on an ad click, classified in class 705, subclass 14.
- II. Claims 1-15 and 21-23, drawn to determining if a user action resulted from an ad, classified in class 705, subclass 14.
- III. Claims 16-20 and 24-26, drawn to offering a tracking option, classified in class 705, subclass 14.
- IV. Claims 31-35, drawn to tracking user actions with both a first and second ad provider, classified in class 705, subclass 14.
- V. Claims 36-37, drawn to tracking user actions with a second ad provider using a first ad provider system, classified in class 705, subclass 14.

At page 2 of the Office Action, the Examiner cites M.P.E.P. § 806.05(d), which states:

Two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, are usually restrictable when the subcombinations do not overlap in scope and are not obvious variants.

The Examiner alleges (Office Action, p. 2):

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination II has separate utility such as receiving information that a user performed a conversion. See MPEP § 806.05(d).

Applicants respectfully submit that the Examiner has not met the burden of establishing that the alleged subcombinations do not overlap in scope, as is required by M.P.E.P. § 806.05(d).

For instance, claim 27 (of Group I) recites, among other features, determining whether the conversion was associated with an ad. Meanwhile, claim 1 (of Group II) recites, among other features, determining whether the conversion resulted from an advertisement provided by a first entity.

As such, Applicants respectfully submits that one or more features of the alleged subcombinations of Groups I and II at least partially overlap in scope. Thus, Applicants respectfully submits that the restriction requirement is improper under M.P.E.P. § 806.05(d).

The Examiner alleges (Office Action, p. 4):

Inventions III and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination IV has separate utility such as providing a tracking option. See MPEP § 806.05(d).

Applicants respectfully submit that the Examiner has not met the burden of establishing that the alleged subcombinations do not overlap in scope, as is required by M.P.E.P. § 806.05(d).

For instance, claim 24 (of Group III) recites, among other features, providing a conversion tracking option to an advertiser, the conversion tracking option including an option to track conversions associated with a second entity, the second entity not being associated with the first entity; and tracking at least some user actions associated with ads provided by the second entity. Meanwhile, claim 31 (of Group IV) recites, among other

features, at least one processor to execute the instructions in the memory to: track users' actions associated with a second ad provider, the first ad provider not being affiliated with the second ad provider.

As such, Applicants respectfully submits that one or more features of the alleged subcombinations of Groups III and IV at least partially overlap in scope. Thus, Applicants respectfully submits that the restriction requirement is improper under M.P.E.P. § 806.05(d).

The Examiner alleges (Office Action, p. 4):

Inventions III and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination V has separate utility such as providing a tracking option. See MPEP § 806.05(d).

Applicants respectfully submit that the Examiner has not met the burden of establishing that the alleged subcombinations do not overlap in scope, as is required by M.P.E.P. § 806.05(d).

For instance, claim 24 (of Group III) recites, among other features, providing a conversion tracking option to an advertiser, the conversion tracking option including an option to track conversions associated with a second entity, the second entity not being associated with the first entity; and tracking at least some user actions associated with ads provided by the second entity. Meanwhile, claim 36 (of Group V) recites, among other features, tracking users' actions associated with a second ad provider, the second ad provider not being affiliated with the first ad provider.

As such, Applicants respectfully submits that one or more features of the alleged subcombinations of Groups III and V at least partially overlap in scope. Thus, Applicants

respectfully submits that the restriction requirement is improper under M.P.E.P.

§ 806.05(d).

The Examiner alleges (Office Action, pp. 4-5):

Inventions IV and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination IV has separate utility such as tracking user actions with both a first and second ad provider. See MPEP § 806.05(d).

Applicants respectfully submit that the Examiner has not met the burden of establishing that the alleged subcombinations do not overlap in scope, as is required by M.P.E.P. § 806.05(d).

For instance, claim 31 (of Group IV) recites, among other features, at least one processor to execute the instructions in the memory to: track users' actions associated with a second ad provider, the first ad provider not being affiliated with the second ad provider. Meanwhile, claim 36 (of Group V) recites, among other features, tracking users' actions associated with a second ad provider, the second ad provider not being affiliated with the first ad provider.

As such, Applicants respectfully submits that one or more features of the alleged subcombinations of Groups IV and V at least partially overlap in scope. Thus, Applicants respectfully submits that the restriction requirement is improper under M.P.E.P.

§ 806.05(d).

Furthermore, in order for a restriction to be proper, the inventions must be independent and there must be a serious burden on the Examiner if the restriction is not made (MPEP § 803). Applicants respectfully submit that Groups I-V are all classified in class 705, subclass 14 and therefore, there is no serious burden on the Examiner.

Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the restriction requirement of claims 1-39 under 35 U.S.C. § 121.

If the Examiner persists in maintaining the restriction requirement, Applicants elect Group II (claims 1-15 and 21-23) with traverse.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1070 and please credit any excess fees to such deposit account.

Respectfully submitted,

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